

## **REMARKS**

Claims 1, 3-4, 6, 10, 11, 13, 14, and 25-26 are pending. Claim 5 is to be canceled.

**Claim 1 has been amended to point out certain features of Applicant's claimed invention. Claim 1 has been amended to include the slot limitation of canceled claim 5. This amended should be entered because it places Claim 1 in better form for consideration on appeal.**

### **1. 35 U.S.C. § 102(e):**

Claims 1, 3, 5-6, 10-11 and 13-14 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lin U.S. Patent Application 2002/0122712.

It is fundamental patent law that anticipation requires that **each** and **every** element of the claimed invention be described, either expressly or inherently, in a single prior art reference. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

Each of the independent claims require in various ways, that a member have a slot disposed at an engaging region.

The accepted definition of slot is “a narrow, elongated, depression, groove, notch, slit or aperture, esp. a narrow opening for receiving or admitting some thing, as a coin or letter.” *See, Random House Webster's Unabridged Dictionary, Second Edition, 2001*, copy attached. It is submitted that recessed hole 54 of Lin is not a slot, as recessed hole 54 is not elongated.

The Examiner contends that recessed hole 54 of Lin is the same as Applicant's claimed slot 18. Without a specific reference to the text or drawings of Lin or any extrinsic evidence describing the recessed hole 54, the Examiner continues with the naked contention that the

recessed hole 54 is a slot. It is respectfully submitted that the recessed hole 54 of Lin departs significantly from Applicant's claimed elongated slot aperture.

**Lin does not expressly describe the present invention**

It is respectfully submitted that Lin is silent about the asserted characteristics of applicant's elongated slot aperture. Contrary to the Examiner's position, Lin does not expressly describe that recessed hole 54 is a slot. Lin discloses that recessed hole 54 is a cylindrical hole sized to receive a cylindrical spring 56 and a spherical ball 58.

It is submitted that Lin does not expressly describe that recessed hole 54 is a slot as the Examiner contends.

**Lin does not inherently describe the claimed invention**

It is further submitted that Lin is silent about any inherent slot characteristic of recessed hole 54. The Examiner has provided no objective evidence or cogent technical reasoning to support such a conclusion of inherency.

Regarding inherent description of the claimed invention in a single prior art reference, the Examiner is directed to MPEP §2112, wherein "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990) (emphasis in original). Further direction is provided in §MPEP 2131.02, wherein "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Lin does not inherently describe that recessed hole 54 may be a slot. It is submitted that one of ordinary skill in the art would recognize that recessed hole 54 would necessarily need to be non-slot like in order to function as receptacle of spring 56 and 58.

The Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination that recessed hole 54 is a slot.

In conclusion, Lin does not teach, expressly or inherently, each and every element of Applicant's claimed invention. As presented above, Lin neither expressly nor inherently teaches a slot aperture being pivotally connected to the vehicle as provided by Applicant's present invention. Accordingly, Applicant requests reconsideration and withdrawal of the anticipation rejection.

**B. Obviousness Rejection is Improper**

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin '920.

Lin '920 alone fails to render obvious the present invention. Lin '920 does not disclose the claimed invention. Specifically, Lin '920 does not disclose a generally planar member having a pair of generally opposed surfaces and a slot therebetween disposed at an engaging region; a coupling member having an external thread set and having a complementary portion for engaging the aperture of the planar member; and a non-planar member having an internal thread set adapted to engage the external thread set of the coupling member thereby connecting the non-planar member to the planar member, wherein portions of the pair of generally opposed surfaces of the planar member extend into the thread set of the non-planar member, and wherein the planar member has more than one aperture.

The arguments set forth above regarding Lin's failure to teach or disclose required claimed elements are reasserted as to the obviousness rejection. As discussed above, the recessed hole 54 is not a slot. For this reason alone, the obviousness rejection is improper.

Additionally, Lin teaches away from the present invention. Lin requires a generally cylindrical hole to receive and retain the spring 56 and ball 58 in place. It is submitted that if recessed hole 54 were a slot then spring 56 and ball 58 would not be retained in place relative to member 5. Without the recessed hole 54 being generally cylindrical, the Lin device would not operate according to its objectives.

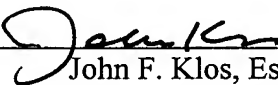
Accordingly, Applicant respectfully requests reconsideration and withdrawal of the obviousness rejections.

### CONCLUSION

Applicant respectfully requests that the Examiner consider the pending claims and arguments. Applicant respectfully submits that, as amended, the subject application is in condition for allowance, and allowance thereof is kindly requested. Should the Examiner wish to discuss these claims further, or should an Examiner's Amendment be needed in order for the claims to proceed to allowance, the Examiner is invited to direct any questions regarding this application to John Klos at (612) 321-2806.

Respectfully submitted,  
Tennant Company, by its attorneys,

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